

REMARKS

Claims 16-32 remain in this application. Claims 16, 18, 19, 21, and 25 have been amended. Claims 28-32 have been added. The Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

35 U.S.C. § 102 Rejection - Horii

The Examiner rejected claim 21 under 35 U.S.C. 102(e) as being anticipated by Horii et al. (6,687,010; hereinafter referred to as "Horii"). The Applicants respectfully submit that claim 21 is allowable over Horii.

As amended, claim 21 recites "*forming a waveguide **in or on** a bottom portion of the prism*". By way of non-limiting example, FIG. 3 of the present patent application shows a waveguide 110 **in** a bottom portion of a prism 100. To further illustrate, as discussed in the patent application at page 5, lines 20-23, the waveguide may be formed in the prism by diffusion, ion exchange, or ion implantation, or the waveguide may be formed on the prism by deposition, for example, chemical vapor deposition. In contrast, Horii does not teach or suggest that the waveguide is **formed in or on** a prism. As shown in FIG. 59 of Horii, the core 172 of the optical fiber is **fused to the side** of the spherical lens 176 it is not **formed in or on** the spherical lens.

Anticipation under 35 U.S.C. Section 102 requires every element of the claimed invention be identically shown in a single prior art reference. The Federal Circuit has indicated that the standard for measuring lack of novelty by anticipation is **strict identity**. "*For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, every element*

of the claimed invention must be identically shown in a single reference.” In *Re Bond*, 910 F.2d 831, 15 USPQ.2d 1566 (Fed. Cir. 1990).

For at least these reasons, claim 21 and its dependent claims are believed to be allowable over Horii.

35 U.S.C. § 103 Rejection - Horii

The Examiner rejected claims 16 and 19 under 35 U.S.C. 103(a) as being unpatentable over Horii. The Applicants respectfully submit that claims 16 and 19 are allowable over Horii.

As amended, claim 16 recites “*a first waveguide in or on a bottom portion of the prism, the rounded top to focus light entering the prism into first waveguide*”. Horii does not teach or suggest these limitations. The discussion above is relevant to this point.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest **all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant’s disclosure. In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

For at least these reasons, claim 16 and its dependent claims, including claim 19, are believed to be allowable over Horii.

Allowable Subject Matter

The Examiner has objected to claims 18, 20, 22-27 as being dependent upon a rejected base claim. The Examiner has indicated that claims 18, 20, 22-27 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Applicants respectfully thank the Examiner for the examination and for the finding of allowable subject matter. While Applicants may elect at another time to write these claims in independent format as suggested by the Examiner, at present the Applicants think that claims 16, 19, and 21 are also allowable and request the Examiner also allow these claims.

Conclusion

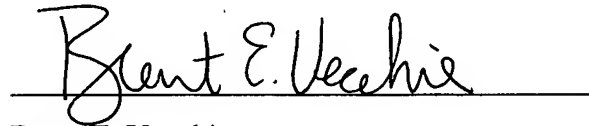
In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned at (303) 740-1980 if there remains any issue with allowance.

Respectfully submitted,

Date: 3-29-05

A handwritten signature in black ink, reading "Brent E. Vecchia", is written over a horizontal line.

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